

REMARKS

Reconsideration and allowance of the subject application are respectfully requested. Claims 8-10, 15, 17-19, 25, 27 and 32 are all the claims pending in the application, as claim 32 is hereby added. No new matter has been added. Applicant respectfully submits the pending claims define patentable subject matter.

Amendment to the Specification

Applicant herein amends the title to remove the term “camera.”

Miscellaneous Claim Amendments

Applicant herein amends independent claims 8 and 15 to improve clarity.

Claim Rejections - 35 U.S.C. § 112

Claim 9 stands rejected for a minor informality. Applicant submits the informality noted by the Examiner is obviated by the amendment made herein. Accordingly, Applicant requests the Examiner reconsider and withdraw the rejection.

Claim Rejections - 35 U.S.C. § 103

Claims 8-10, 15, 17-19, 25, and 27 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Tullis (U.S. Patent 6,535,243) in view of Takemura (JP 11-88672) in view of

Tabata (U.S. Patent 6,198,542). Applicant respectfully traverses the rejection for the following reasons.

Independent claim 8 recites, in part:

a receiving/supplying unit which receives photographed image data and additional information from a camera having an image sensor and capable of obtaining the photographed image data;

an information processing unit which determines information relating to image processing in accordance with said additional information,

wherein said camera is connected with plural types of external apparatuses provided as said information processing unit wherein an order of priority is preliminarily set among the plural types of the external apparatuses,

wherein image processing is performed according to the priority of the plural types of external apparatuses, and

wherein said additional information is at least one of an adjustment parameter of deterioration of marginal lumination of said camera, an adjustment parameter of poor focus of said camera, an adjustment parameter of gradation control of density or color of an image, an adjustment parameter of sharpness enhancement processing or smoothing processing of the image, an adjustment parameter of geometrical adjustment of the image and information relating to designation of an applicable area of these image processing, said additional information is set in said camera by a user.

The Examiner concedes that Tullis fails to disclose the claimed receiving/supplying unit which receives additional information, and the information processing unit which determines information relating to image processing in accordance with said additional information, wherein said additional information is at least one of an adjustment parameter of deterioration of marginal lumination of said camera, an adjustment parameter of poor focus of said camera, an adjustment parameter of gradation

control of density or color of an image, an adjustment parameter of sharpness enhancement processing or smoothing processing of the image, an adjustment parameter of geometrical adjustment of the image and information relating to designation of an applicable area of these image processing, said additional information is set in said camera by a user.

However, the Examiner asserts that Takemura teaches these features and states:

it would have been obvious to one of ordinary skill in the art at the time the invention was made to have sent photographed image data with additional information to an external apparatus as disclosed by Takemura in the apparatus disclosed by Tullis in order for the user to get the desired finished photo they intended.

Applicant respectfully disagrees with the Examiner's position.

Tullis discloses the host computer 10 may process the digital image taken by the camera 40 into an enhanced digital image which can be transmitted back to the camera 40 and displayed.¹ If one of ordinary skill in the art intended to use the host computer 10 and camera 40 of Tullis, she would have only expected to receive the enhanced digital images Tullis provides. That is, one of ordinary skill in the art would not have combined the references "in order for the user to get the desired finished photo they intended," since, if they intended to use the method and system of Tullis, they would have intended and expected to receive only the finished photos within the disclosed capability of Tullis.

¹ See Tullis, Abstract.

Therefore, Applicant submits one of ordinary skill in the art, at the time the invention was made, would not have combined the references as the Examiner suggests.

The Examiner further admits Tullis and Takemura fail to disclose wherein said camera is connected with plural types of external apparatuses provided as said information processing unit wherein an order of priority is preliminarily set among the plural types of the external apparatuses, and wherein image processing is performed according to the priority of the plural types of external apparatuses. Nevertheless, the Examiner asserts Tabata discloses these claimed features, and cites several portions of Tabata in support of her position.² Applicant submits the Examiner's reliance on Tabata is misplaced.

Instead, Applicant points out that no priority is set among external printing apparatuses in Tabata. On the contrary, the "priority" set in Tabata only pertains to setting a priority among different desired printing conditions.³ In other words, in the method and system of Tabata, an operator inputs desired printing conditions (i.e., functions such as two-sided copying, sorting, stapling, etc.) with an order of priority, and the system retrieves the apparatuses corresponding to the conditions (i.e., the apparatuses having the functions) among a plurality of image recording apparatuses connected to a network to display the retrieved result.⁴ Finally, the operator selects the apparatus to be used from among the

² See Tabata, FIGS. 8-11; col. 9, lines 40-47; col. 9, line 66 to col. 10, line 41.

³ See Tabata, FIG. 8 and col. 9, lines 35-51.

⁴ See Tabata, FIGS. 8-10 and col. 9, lines 26-49.

retrieved apparatuses.⁵ In other words, in Tabata, the system does not set any priority among different external apparatuses, but merely among desired printing conditions, from which a single image forming apparatus is selected.⁶

Indeed, Applicant notes that the Examiner admits:

[t]he user preliminarily selects and prioritizes which features about the external apparatuses are important to the user.⁷

Thus, it is undisputed that the features, or printing conditions, which are prioritized in Tabata. However, the Examiner goes on to assert:

[t]he computer then goes and makes a list of the external apparatuses that best meet the conditions the user has set forth and lists them in order of priority that has been set preliminarily.

Applicant respectfully disagrees with the Examiner's position that the making of the list in Tabata corresponds to the claimed features wherein an order of priority is preliminarily set among the plural types of the external apparatuses, and wherein image processing is performed according to the priority of the plural types of external apparatuses.

Instead, Applicant points out, in Tabata, priorities of printing conditions are set, and the computer then simply lists the apparatuses capable of performing the desired functions, but not necessarily in the order of priority of the printing conditions selected.⁸ For example,

⁵ See Tabata, col. 9, lines 43-51, col. 8, lines 37-39 and col. 10, lines 35-41.

⁶ Id.

⁷ See Office Action, page 5, first full paragraph (emphasis added).

⁸ See Tabata, col. 9, lines 40-48.

low priority functions are sometimes disregarded in Tabata.⁹ In fact, a suitable device for performing the desired printing conditions may not be found at all.¹⁰ Just because a priority for a printing condition is set, does not mean that a priority for a corresponding device will be set. Thus, setting priority among printing conditions does not equate to setting priority among devices.

As a further example, Applicant notes that in Tabata, an example is described, wherein the “stapling” function is selected.¹¹ Tabata goes on to state, if the stapling function is a low priority function, the apparatus is listed anyway, despite the fact that it does not perform the desired stapling.¹² In such a case, assuming, *arguendo*, setting priority based on the printing conditions corresponds to the claimed setting an order of priority among external apparatuses, Tabata would clearly not teach or suggest the claimed feature of wherein image processing is performed according to the priority of the plural types of external apparatuses, since the performing of the stapling is complete disregarded in Tabata.

Furthermore, Applicant submits setting a priority based on a “printing condition,” as taught by Tabata, either alone, or combined with the disclosures of Tullis and Takemura, does not inherently disclose the claimed feature of setting a priority among plural external apparatuses. For example, under Tabata, setting a “priority” among different desired printing

⁹ See Tabata, col. 9, lines 59-65.

¹⁰ Id.

¹¹ See Tabata, col. 10, lines 6-12.

¹² Id.

conditions would not necessarily set a priority related to the availability of any particular device, or the desired ordering of output to different types of external apparatuses. Instead, the “priority” set in Tabata merely refers to setting the order of desired processes such as stapling, sorting, copying, etc., to be performed on one output device. In other words, the features are selected and prioritized, not the external apparatuses themselves. Accordingly, Applicant submits the prior art of record is deficient in this regard.

Moreover, the order of priority of the printing conditions in Tabata is merely used as a retrieval key of the apparatus, and the operator designates, among the apparatuses listed among the retrieved results, the most convenient apparatus for performing the printing conditions. Accordingly, the order of priority of the printing conditions in Tabata does not correspond to the order of priority among the external apparatuses, as claimed.

Therefore, Applicant submits none of the references, either alone or in combination, disclose all of the above-noted features of the claimed invention. Accordingly, Applicant submits independent claim 8 is patentable over the applied references for at least these reasons. Similarly, Applicant submits independent claim 15 for reasons analogous to those stated above regarding independent claim 8. Further, Applicant submits dependent claims 17-19, 25 and 27 are also patentable over the applied references, at least by virtue of their respective dependency on independent claims 8 and 15.

Regarding the combination of the cited references, the Examiner argues:

[i]t would have been obvious to one of ordinary skill in the art at the time the invention was made to have designed a system connected to one or more external apparatus with priorities preliminarily set as taught by Tabata with the camera in the

Tullis in view of Takemura reference in order to allow the camera to send image data to external apparatuses for different image data processing (printing, recording, and transmitting) in any desired order.

Again, Applicant respectfully disagrees with the Examiner's position.

Even assuming, *arguendo*, that the prior art of record disclosed all of the claimed features, Applicant submits that one of ordinary skill in the art at the time the invention was made would not have been motivated to combine the references as the Examiner suggests.

As pointed out above, Tabata merely discloses a system and method wherein a user sets priorities of desired printing conditions. The computer then system selects the single-most convenient apparatus for the printing conditions selected.

Tullis, on the other hand, discloses a system having a digital camera and only a single host computer, where the computer performs all of the image processing. Thus, in Tullis, the image data is transmitted from the camera to the host computer, and the host computer performs any one of several different image processing tasks. Further, Takemura discloses a method and system for confirming and carrying out image processing corresponding to a desired finish of digital image data.¹³

Tullis applies only to single image processing devices,¹⁴ whereas Tabata applies to a selection among plurality of image forming apparatuses, based on the above-noted printing conditions. Assuming, *arguendo*, the cited references disclose all of the claimed features, Applicant submits any combination of the two would impermissibly destroy the principle of

¹³ See Takemura, Abstract.

¹⁴ See Tullis, Abstract.

operation of each,¹⁵ and further, make each unsatisfactory for its intended purpose, since there would be only one device performing image processing, and thus, there would be no need to select priorities among plural external devices. Similarly, using just one device to implement the system of Tabata would defeat the operation and intended purpose of Tabata to control a network of image forming apparatuses.¹⁶

Further, Tullis discloses:

The communications link between the handheld digital camera and the host computer can transfer data at a sufficiently high bandwidth to provide virtually real-time feedback to a computer operator.¹⁷

Thus, if one skilled in the modified Tullis to incorporate multiple external devices, as in Tabata, the desired efficiency of the communication link between the camera and the host computer in Tullis would be compromised, since the communication would have to exist with respect to multiple devices, instead of just one computer. As such, Tullis' clearly stated principle of operation, i.e., "transferring data at a sufficiently high bandwidth to provide virtually real-time feedback" would be changed.

Moreover, such a proposed modification would render Tullis unsatisfactory for its intended purpose, because the critical nature of "real-time feedback" would be unpredictably changed. Therefore, Applicant submits there is no suggestion or motivation to make the

¹⁵ See MPEP § 2143.01 (VI).

¹⁶ See Tabata, Abstract, and col. 3, lines 39-44.

¹⁷ See Tullis, Abstract.

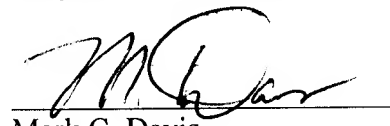
proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).¹⁸
Indeed, such a modification would yield unpredictable results with regard to the effectiveness of the communication link, and thus, the rejection is clearly at odds with the Supreme Court decision in *KSR Int'l. Co. v. Teleflex, Inc.*

Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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CUSTOMER NUMBER

Date: October 17, 2007

¹⁸ See also, MPEP, § 2143.01 (V).